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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,181	09/24/2001	Takuro Ikeda	1405.1050	7175

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EXAMINER

SMITH, TRACI L

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/961,181

**Applicant(s)**

IKEDA ET AL.

**Examiner**

Traci L. Smith

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to papers filed on July 10, 2006.

Claims 1-11 have been amended.

Claims 1-11 are pending.

Claims 1-11 are rejected.

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2006 has been entered.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 and 9-11 rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,766,319 Might; Method and Apparatus for Gathering and Evaluating Information. Hereinafter, referred to as Might. The reference cited in this rejection is applied to the above mentioned claims as they are best understood by the examiner.

3. As to claims 1-2, 5-6 and 9-11 Might teaches

- a. Inputs with respect to specific topics(ie categories, products) that were previously stored(C. 2 I. 59-63).
- b. Picking which topic the individual wishes to participate in.(C. 3 I. 23-26).
- c. Communication between survey supplier and individual(C. 1 I. 20-23).
- d. Storing information from communication (C. 2 item 8).
- e. Store reports requested by user in a specific location(C. 20 I. 43-45 and 59-65)
- f. Reporting communication information(C. 3 I. 16-21).
- g. Databases for storing several different items and aspects of the information gathering process. (C. 9 I. 50-55; C. 10 I. 49-52; C. 13 I. 18-30)

4. Although, does not explicitly recited the information being "merchandise information" as recited in claims 5-6 it is inherent ~~if~~ if an individual is a customer they will be reporting on the "merchandise" was purchased or used from the provider.

Furthermore, the fact that the information is "merchandise information" these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of information input. The claims fail to recite a manipulation of the information that is collected there,

they are merely input and the transmitted in the same form in which they were input. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

5. As to claim 3 Might teaches storing customer information that identifies the customer via information input by the customer(C. 3 l. 66-67 & C. 4 l. 1-3)

6. Might further teaches using statistical information rather than raw information therefore removing the users identity from the survey input information.

7. As to claims 4 Might teaches storing the communication information(C. 1 l. 20-23).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,766,319 Might as applied to claim 1-6 and 9-11 above, and further in view of US Patent Publication 2001/0032115 A1 Goldstein; System and Methods for internet commerce and communication based on customer interaction and preferences.

Hereinafter referred to as Goldstein. The references cited in this rejection are applied to the above mentioned claims as they are best understood by the examiner.

11. As to claims 7-8 Might teaches a system and method for users inputting information regarding products/services or merchandisers. Might fails to teach a means for billing/compensation and notification of billing/compensation information. Goldstein teaches purchasing information for survey information that a user requests from a survey they did not develop. Goldstein further teaches a portion of the proceeds going to the creator the survey as a means for compensating the creator for their work. It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Goldstein with Might so as to have incentives to both using others surveys and creating surveys that other will be able to use the data from.

### ***Response to Arguments***

12. Applicant's arguments filed July 10, 2006 have been fully considered but they are not persuasive.

13. As to applicants arguments that Might fails to teach transmitting to "multiple destination addresses". The examiner first notes that when given the broadest reasonable interpretation of the language "destination addresses" it is not limited to applicants interpretation of "servers". The addresses could also be email address or

physical addresses. The addresses could be interpreted to be any destination the information is supposed to be sent(transmitted). The examiner notes that as stated before Might teaches the system taking place over the internet., which the examiner maintains it being inherent to transmit information to multiple servers. Examiner has included definitions of both the internet and servers for applicants review regarding the "operation" of the internet. Applicant additionally uses case law which further supports examiners statement of inherency. Applicant quoted case law "Toro Co. V. Deere & Co., 355 F.3d 1313 C.A. Fed. (Minn.) 2004 "a fact that a characteristic is a necessary **feature or result of the prior art embodiment sufficiently described and enabled, suffices for an inherent disclosure, even if such feature or result was unknown at the time of the prior art invention.**" Therefore, because Might states the system can be performed over the internet and; the internet is defined as connecting computer networks and organizational computer facilities around the world; Might sufficiently describes the use of multiple servers.


14. Applicants arguments regarding claims 7-8 are not persuasive in view of responses stated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLS



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